

03 MAY 22 PM 11:31

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

John Eckl

Attorney Docket No.: F-278

Serial No.: 09/903,500

Group Art Unit: 3622

Filed: July 12, 2001

Examiner: Myhre, James W.

For: BILLING SYSTEM WITH
ELECTRONIC AND PRINTED
DISTRIBUTION

Date: May 13, 2003

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The appellant respectfully submits the following reply brief in response to the Examiner's Answer of March 19, 2003, in the appeal of the subject application. Appellant's Brief was filed January 30, 2003, and the Notice of Appeal was filed on November 1, 2002, following a Final Office Action mailed August 1, 2002.

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to:

Patent and Trademark Office

Attention: James W. Myhre, Patent Examiner

Facsimile No. : (703) 872-9326

on May 13, 2003

Date of Transmission

Marlene Olphonice

Name

Marlene Olphonice
Signature

May 13, 2003
Date

The Prepayment Authorization Agreement of Comesanas
Does Not Determine Method of Delivery

In his Answer, the Examiner relied on Claims 3 and 4 of the Comesanas reference (U.S. Patent 5,802,498) as supplying a disclosure that a certain "agreement to pay transmittal charges," described in Comesanas, includes disclosure of a recipient "delivery preference" as recited in the rejected claims. As is clear from the specification of Comesanas, the "agreement to pay transmittal charges" relates to a pre-authorization to deliver a pre-paid return envelope and to include the corresponding charge on an invoice. What is missing in Comesanas is a nexus from this transmittal charge "agreement" to the presently claimed "delivery preferences" indicating printed or electronic transmittal.

In his Answer, the Examiner filled in the missing piece as follows, "Since the system must determine which invoices to send electronically and which invoices to send through the postal mail, and since the system decides this by looking in the database to see which debtors have authorized the system to charge a transmittal fee for the corresponding method of transmittal, the Examiner considers the authorization received from the debtor to be an indication of the transmittal preference of that debtor." Answer page 12. This statement is factually unsupported, and is directly contradicted by the very language relied upon.

The statement is unsupported because nothing in Comesanas describes or suggests that a determination of physical or electronic delivery depends on the authorization statement from the intended recipient. That conclusion is an incorrect assumption by the Examiner, most likely based on hindsight in view of the present invention.

Contrary to the Examiner's assertions, claims 3 and 4 demonstrate how the determination of electronic or physical delivery is independent of the authorization agreement. As seen in Comesanas, billing information is gathered "from selected ones of said debtors from whom a payment is required so as to generate an invoice for each of said selected debtors." Lines 42-44. Thus, an all encompassing group of debtors to

receive invoices is formed. Within that larger group are those who are determined to have signed the transmittal charges agreement. Lines 44-47. For those who signed the agreement, extra steps are taken, but all "selected debtors," including those who have not signed an agreement, receive their invoices.

For the inclusive "said invoices," a determination is made whether to send electronically or by mail. Lines 50-52. If by mail, such invoices are printed on paper. Lines 52-53. However, for those debtors who signed the agreement, the extra charge and the prepaid envelopes are also included. Lines 47-50 and 54-56. Accordingly, debtors who have never signed any authorization agreement continue to receive their invoices, just the contents are different. The claims clearly distinguish the larger group of "said invoices" from the sub-group relating to those "of said selected debtors who signed such an agreement." The delivery "each of said invoices" is determined and made without regard to "such an agreement." Lines 50-53. Thus, as expressly described in claims 3 and 4 of Comesanas, the delivery method of the invoice is never affected by the authorization agreement, or lack thereof, and only the contents of the documents are changed. As such, Comesanas fails to disclose "delivery preferences" as recited in the rejected claims. The passages of Comesanas relied upon by the Examiner demonstrate that the prepayment authorization agreements are not tied with any determination relating to delivery.

Official Notices

For certain dependent claims, the Examiner has relied on statements of Official Notice for disclosure of certain steps and elements. Because Appellant has decided that this Appeal will stand or fall based on elements missing from the independent claims, those arguments are not presently pertinent. However, Appellant does not concede that the Examiner's statements of Official Notice, even if true by themselves, are sufficient to meet the requirements for anticipating the claim element or for combination with the other elements.

For example, one Official Notice states that "it is old and well know within the database art to place use [sic] a table format to save memory space when storing such data." Such Official Notice is insufficient, however, for providing a disclosure or

suggestion that information to be stored is delivery preferences, or for combining a particular memory technique with other elements. Other such Official Notices are not to the point for which they are asserted. As such, Appellant reserves all rights to unargued claim elements, particularly in the dependent claims.

For the reasons advanced above, the Appellant respectfully submits that claim 12 and 14-36 are patentable. All briefing now being concluded, reversals of the rejections by the Examiner are respectfully solicited.

Respectfully submitted,



Michael J. Cummings

Reg. No. 46,650

Attorney for Appellant

Telephone (203) 924-3934



Pitney Bowes Inc.

Corporate Counsel
Intellectual Property & Technology Law
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000
203-924-3934
203-924-3919 Fax
Michael.Cummings@pb.com
www.pitneybowes.com

Facsimile

To: Myhre, J.W.
Group Art Unit: 3622
Fax No.: (703) 746-5544
From: Michael J. Cummings
Date: May 13, 2003
Subject: 09/903,500 (F-278)
Pages: 5 pages including cover sheet

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that the following correspondence is being transmitted **via facsimile** to:

Patent and Trademark Office
Attention: James W. Myhre Facsimile No. 703 746-5544

1. Appellant's Brief dated May 13, 2003 for 09/903,500 (F-278)
(5 pages)

on May 13, 2003
Date of Transmission

Marlene Olphonice
Name


Signature

May 13, 2003
Date